

09/753,954

-15-

PC9978A

REMARKS

Following entry of the present amendment, Claims 1-6 and 10-11 remain in the application. Only Claim 1 is in independent form.

Claim 9 stands rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has hereby cancelled Claim 9 thereby rendering moot any objection thereto.

Accordingly, in view of the comments set forth above, Applicants request withdrawal of this rejection under 35 U.S.C. §112, second paragraph.

Claims 9 and 10 stand rejected under 35 U.S.C. §112, first paragraph, because the specification, while enabling a method of treating pain, allegedly does not reasonably provide enablement for the treatment of all other indication recited in the claims.

Applicants have amended Claim 10 to more clearly define the present invention. In further support of amended Claim 10, Applicants provide herewith scientific publications that support the link between the ORL-1 receptor and (cardiovascular function, hypotension, bradycardia, blood pressure) *S. Giuliani, et al, Eur. J. Pharmacology*; 1997 Vol. 333, pp 177-179, (hypotensive activity), *H. Champion, et al, Pharmacology Letters*, 1997, Vol. 60, No. 16, pp 241-245, (anxiety), *F. Jeneck, et al., Proc. Natl. Acad. Sci. USA*, 1997, Vol. 94, pp 14854-14858, and (hyperalgesia, hyperlocomotion, memory disorders) *T Manabe, et al., Nature*, 1998, Vol. 394, pp 577-582. Applicants have herewith provided copies of all of the references set forth above. Applicants respectfully submit that Claim 10 is fully enabled.

Further, Applicants respectfully submit that the publications provide further support for the treatment of a disorder or condition which can be effected or facilitated by activating ORL1-receptor. Accordingly, Applicants respectfully request reconsideration withdrawal of the rejection of Claims 9 and 10 under 35 U.S.C. §112, first paragraph.

Claims 1-6 and 9-11 stand rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over Claims 1-9 of United States Patent Number 6,172,067. It is respectfully submitted that the claims of US Patent Number 6,172,067 do not provide any suggestion or motivation that would lead one of ordinary skill in the art to choose the specific invention claimed herein. Specifically, Applicants point to substituent "Y"

09/753,954

-16-

PC9978A

of the presently pending claims. As defined in the presently pending claims, substituent "Y" is neither taught nor suggested by US Patent Number 6,172,067. In the absence of a specific motivation in the art itself to give one of ordinary skill a reasonable expectation of success, there can be no assertion of obviousness. Accordingly, Applicants respectfully submit there is no basis for asserting the obviousness of the particular compounds of the present invention and Applicants request withdrawal of this rejection. Upon the allowance of claims for the present application, Applicants would reconsider the filing of a terminal disclaimer to obviate the pending rejection.

In view of the foregoing remarks, Applicants respectfully submit that the application is in condition for allowance, which allowance is respectfully solicited.

The Commissioner is authorized to charge any fee or credit any over payment in connection with this communication to our Deposit Account No. 23-0455.

Respectfully submitted,

Dated: January 15, 2004



David R. Kurlandsky
Registration No 41,505
Warner-Lambert Company
2800 Plymouth Road
Ann Arbor, MI 48105
Telephone: (734) 622-7304
Facsimile: (734) 622-1553